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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/421,629	10/19/1999	JAY M. SHORT	DIVER1260-3	4408

7590

10/20/2004

LISA A HAILE
GRAY CARY WARE & FREIDENRICH LLP
4365 EXECUTIVE DRIVE
SUITE 1100
SAN DIEGO, CA 92121-2133

EXAMINER

NASHED, NASHAAT T

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/421,629

Applicant(s)

SHORT ET AL.

Examiner

Nashaat T. Nashed, Ph. D.

Art Unit

1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 22 June 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 48, 49, and 52-63.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


Nashaat T. Nashed, Ph. D.
Primary Examiner
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Upon entry of the amendment, claims 48, 49, and 52-63 will be pending and under consideration and the following rejection(s) is applicable to the claims.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 48, 49, and 52-63 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for the reasons set forth in the prior Office actions mailed May 27, 2003 and December 24, 2004.

Applicants continue to argue that the claimed proteins are fully described, and that if the method is novel the product of the method is novel.

Applicants' arguments filed 4/26/04 have been fully considered but they are not deemed to be persuasive. The examiner disagrees. The specification describes and enables a method of identifying a protein or nucleic acid of interest, but it does not even describe a single protein or nucleic acid of interest, i. e., a product of the method, let alone, any protein produced by said method. The claims remain rejected.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 48, 49, and 52-63 are rejected under 35 U.S.C. '102(b) as being anticipated by the commercial availability of numerous commercial enzymes such as subtilisines, lipases, protein kinases, oxidases and glucosidases as well as the nucleic acids sequences, proteins, peptides and enzymes known in commercial databases, for the reasons set forth in the prior Office action mailed May 27, 2003 and December 24, 2004.

In response to the final Office action mailed December 24, 2004, Applicant cites another court decision to support their claims of novelty of a product by process method, Scripps Clinic & research Fund Vs. Genentech, Inc. (18 USPQ2d 1001 (Fed.

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Cir 1991)]. He argues that the court found a product is novel when the method of its making novel.

Applicants' arguments filed 4/26/04 have been fully considered but they are not deemed to be persuasive. As indicated in the prior Office actions, the patentability of the product of a method resides in the novelty of the product itself and not the method by which it is made or identified. The claimed protein invention is a chemical compound that is not described in the specification by any physical or chemical properties, and therefore can't be distinguished from many commercially available proteins and enzymes. The issues in this case and those in Scripps Clinic are different. In the Scripps Clinic, the issues regarding a degree of purified product, which is not the issue in this particular application. The examiner could not even find the phrase "if the method is novel, the product of the method is novel. In this application, applicant is attempting to claim a protein product without structure, physical or chemical properties and the novel claimed method has the potential of producing many of the well-known proteins and enzymes. Thus, the claims remain rejected for the reasons set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nashaat T. Nashed, Ph. D. whose telephone number is 571-272-0934. The examiner can normally be reached on MTTF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Nashaat T. Nashed, Ph. D.
Primary Examiner
Art Unit 1652